BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI

Opinions of the Courts Below

The opinion of the United States District Court for the District of Connecticut is reported in 62 Fed. Supp. 42-65.

The opinion of the Circuit Court of Appeals for the Second Circuit appears at pages 281 *et seq.* in Volume C of the transcript of record.

Jurisdiction

Jurisdiction of this Court is invoked under Section 240a of the Judicial Code as amended by the Act of February 13, 1935 (28 U. S. C. Section 347). The judgment of the Circuit Court of Appeals for the Second Circuit which petitioner seeks to have reviewed was entered January 10, 1946 (288C).

Statement of the Case

The essential facts of the case are stated in the accompanying petition for a writ of certiorari.

Specification of Errors

The error which petitioner will urge if the writ of certiorari is issued is that the Circuit Court of Appeals for the Second Circuit erred:

In holding that the practice of the patented process by the inventor in secret with a commercial purpose more

than one year prior to the date of application for the patent effected a forfeiture of the inventor's right to the patent, thus rendering the patent invalid; and in dismissing the complaint.

Summary of Argument

The points of the argument will follow the reasons relied on for the allowance of the writ. We desire, however, at this point, to say that we find it very difficult, after most careful analysis of the opinion of the Second Circuit Court of Appeals, to make any clear statement, with reference to the statute, of the ground upon which the Court rested its denial of the inventor's right to a valid patent.

The defenses pleaded under the statute (R.S. 4886 and 4920) were (1) prior public use and (2) abandonment.* The trial court made findings of fact which preclude abandonment, and concluded that the defense of abandonment had not been sustained. The Circuit Court of Appeals accepted these findings and clearly stated that its decision did not rest on abandonment. Thus, speaking of the forfeiture which it found in the inventor's secret use of his process more than one year prior to his application with a commercial purpose, which it characterized as "competitive exploitation • • • of his process", the Court said (287 A):

> "Such a forfeiture has nothing to do with abandonment, which presupposes a deliberate, though not necessarily an express, surrender of any right to a patent".

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* 8 A, folio 23 and 9-10 A, par. 8, of the Supplemental Answer.

As to the pleaded defense of public use, the trial court expressly found that the use was not public but secret, so that there had been no contribution to the art by the inventor or anyone else of knowledge of the process, and the Court of Appeals accepted that finding.

Defendant having thus failed, as to each of the two defenses (abandonment and prior public use), to prove the supporting facts pleaded, the District Court gave judgment for plaintiff. The Court of Appeals, although it accepted the District Court's findings of fact, reversed the judgment because the secret use by the inventor with commercial purpose continued more than one year before the application was filed.* Although the opinion of the Court of Appeals clearly says that the reversal was not on the ground of abandonment, nowhere does it expressly say whether its decision rests on the ground of prior public use. There is much in the opinion to indicate that the Court felt that the statutory provision as to prior *public* use could and should be interpreted to include a prior *secret* use by the inventor with commercial purpose, but no express statement to that effect.

We prefer, however, not to obscure our discussion of the need for exercise of this Court's power of supervision in this case by trying to say whether the Circuit Court of Appeals intended to rest its decision on the "public use" section of the statute or on what seemed to it sound considerations outside of and beyond those statutory bars which the statute expressly erects.

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* It should be noted that the pleading of prior secret use did not include any averment that the secret use had been for more than one year before the application was filed, or any allegation of forfeiture on that ground (Supplemental Answer, par. 8, 9-10 A).

The nub of the matter is fairly presented, we believe, by saying that the Circuit Court of Appeals has found that a patentee forfeits his right to an otherwise valid patent, if he secretly uses the invention in commercial competition and allows that secret use to continue more than one year before he files his application. The one-year period was certainly derived by the Court from the statute, and the asserted forfeiture is of like character with the statutory forfeiture which occurs when the patentee puts off filing his application more than one year after it has been patented or described in any printed publication in this or any foreign country or has been in public use or on sale in this country; a forfeiture which results invariably from the passage of time, whether the prior patenting or publication or prior public use was by the inventor or someone else and without regard to any other conduct or intention of the inventor or any circumstances whatever other than the mere lapse of time.

We have not found in this Court any case in which such a forfeiture of the right to an otherwise valid patent has been asserted in that form or discussed from that point of view. There is, however, at least one case in this Court (*Kendall* v. *Winsor*, 21 How. 329), in which the patent was sustained in spite of the existence of all the factual conditions upon which the Circuit Court of Appeals rested its decision, thus presenting a direct conflict. There are several other cases in which the non-existence of that rule of forfeiture is necessarily implied by the decisions of this Court. And there are similar cases of direct conflict and of conflict by necessary implication with other Circuit Courts of Appeals, with District Court decisions and with the Court of Customs and Patent Appeals.

Furthermore, there are decisions of this Court which preclude the idea that forfeiture by secret use can be predicated on the "public use" provision of the statute.

The Court of Appeals has decided a federal question in a way probably in conflict with applicable decisions of this Court.

In *Kendall* v. *Winsor,* 21 How. 322 (1858), the patent was for a machine for making harness. The inventor built one machine in 1846 and four in 1849 and filed his application in November 1854. During this period from 1846 to 1854 he took precautions to keep his machine secret but he sold the harness made by the machine on all orders he obtained (p. 324).*

The applicable statute then in force, Section 7 of the Act of 1839, contained provisions similar to those of the present statute. It made public use more than two years prior to the application a bar to patenting.** It also made abandonment a defense.

There was some suggestion that the inventor's use of the invention for a period of nearly eight years prior to his application was experimental but the district court refused to charge on this subject and treated the case as one

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* The Second Circuit Court of Appeals recognized (285A) that the facts in the *Kendall* case "presented the same situation as here" but believed "the case adds nothing" because it erroneously thought that "The jury brought in a verdict for the defendant." The fact is the "jury found a verdict for plaintiff" (21 How. 322).

** See *Andrews* v. *Hovey,* 123 U. S. 267, 271, 274, interpreting this statute. The word "public" was not actually in the statute but the word "use" was always interpreted to mean public use. *Andrews* v. *Hovey, idem.*

of the use of a completed machine (p. 325-7). It is plain that if the inventor's secret use of his machine for more than two years prior to application accompanied by sales of its product constituted the invariable forfeiture now found by the Second Circuit Court of Appeals the case would have ended then and there in a directed verdict for defendant. The trial Judge charged the jury, however, that in order to constitute abandonment "in a case where it did not appear any sale of the *thing patented* had been made, and there was no open public exhibition of the machine" an actual intent to relinquish the right to a patent must be found (p. 327).

This court emphasized that abandonment involves "an inquiry or conclusion of fact • • • peculiarly within the province of the jury" and approved the instruction of the trial court saying (p. 331):

> "• • • we consider that instruction to be in strict conformity with the principles hereinbefore propounded, and with the doctrines of this court, as declared in the cases of Pennock v. Dialogue and Shaw v. Cooper."

Thus the decsion of this court in *Kendall* v. *Winsor* in 1858 is in direct conflict with the decision of the Second Circuit Court of Appeals in the case now sought to be reviewed. All of the facts which make up the forfeiture found by the Court of Appeals in the instant case, and which led it to hold the patent invalid, were present in the *Kendall* v. *Winsor* case, yet this court approved instructions of the trial court which resulted in a holding of validity.

The next case of apparent conflict in this court is *Manning* v. *Cape Ann etc. Co.* 108 U. S. 462 (1882). In this

case the patent was for a process of making isinglass which involved the use of a machine of known design. The inventor, Manning and his partner Norwood used the process commercially in competition for profit in their business of manufacturing isinglass from 1860 to 1867. They then separated, Norwood retaining the machine and continuing a like use of the process until 1870. Manning established his sons in partnership and they also used the process commercially from 1868 to 1873. The patent was applied for in 1873.

It was claimed that the use of the process "was a secret and not a public use". But this court upon examination of the evidence, concluded that the use of the process was "open to the public generally". It also pointed out that Norwood after the dissolution of the partnership was "allowed * * * the unrestricted use of the patent * * *, without injunction of secrecy or other condition. This is sufficient to constitute a public use" (p. 465).

If the rule of forfeiture adopted by the Second Circuit Court of Appeals in the instant case had existed, that would have disposed of the case without regard to any question as to whether the use of the patented process was public or secret, for the use was admittedly commercial and for over two years prior to the filing of the application. The fact that this court found it necessary to examine the evidence and resolve the issue as to whether the use of the process was secret or public and to base its decision on the resolution of that issue denies the existence of the invariable rule of forfeiture adopted by the Second Circuit Court of Appeals in the instant case.

The next case is *Smith, etc. Co.* v. *Sprague,* 123 U. S. 249 (1887). The patent was for a machine for making shoe

buckles. The inventor had used the machine in his factory and had sold large quantities of buckles more than two years prior to his application. This court held the use a public use saying: "It was a public use in the sense of the statute and within the decisions of this court, inasmuch as it was used by the complainant in the regular conduct of his business by workmen employed by him in its operation, and in the view of such part of the public as chose to resort to his establishment, either for the purpose of selling material for the manufacture or of purchasing its product" (p. 254). And in reviewing the evidence the court referred to testimony establishing that no attempt was made to keep the operation of the machine secret from all comers (p. 260).

The decision of this court in *Smith, etc. Co.* v. *Sprague* is, therefore, like its decision in the *Manning* case just discussed, one which presents by necessary implication a conflict with the decision of the Second Circuit Court of Appeals in the instant case.

The fourth case is *Electric Battery Co.* v. *Shimadzu*, 307 U. S. 5 (1938). In this case the defense of prior public use by defendant was raised against two of the patents in suit which claimed a process and a machine for producing lead oxide and the product of that process. Defendant had used plaintiff's process and machine for the production of lead oxide used in the manufacture of storage batteries which were sold in quantity more than two years prior to the application date (p. 20). This court was, therefore, confronted by the question whether this "commercial use * * * is, in contemplation of law, a public use within the meaning of R.S. 4886" (p. 19). The court said:

> "A mere experimental use is not the public use defined by the Act, but a single use for profit, *not purposely hidden,* is such." (p. 20) (emphasis ours)

In discussing the evidence the court pointed out

> "There is no finding, and we think none would have been justified, to the effect that the machine, process, and product were not well known to the employees in the plant, or that efforts were made to conceal them from anyone who had a legitimate interest in understanding them." (p. 20)

Thus this court again made the test of public use whether the patented process and machine were in fact used in public. The fact that defendant used the process and machine commercially and the product was sold competitively was not determinative of the issue of public use although it excluded the suggestion of experimental use.

If the decision of the Second Circuit Court of Appeals here sought to be reviewed is predicated on the "public use" provision of the statute, then it is in conflict with the decision of this court in this *Shimadzu* case, which precludes the idea that forfeiture by secret use can be predicated on the public use provision of the statute. The statutory provision as to public use makes no distinction as to whether the use that made the invention available to the public was by the inventor or by a person other than the inventor. This court in applying the public use provision of the statute has always treated use by the inventor and use by others than the inventor alike. See, for instance, the *Manning* case, 108 U. S. 462, *supra.*

The Court of Appeals has rendered a decision in conflict with decisions of other Circuit Courts of Appeals on the same matter and in conflict with decisions of the Court of Customs and Patent Appeals and of District Courts in other circuits.

In *Penn etc. Co.* v. *Conroy* (C. C. A. 3) 159 Fed. 943 the patent was for a machine for ornamenting glass. The machine was used secretly by the inventor in his factory and the product of the machine was sold commercially more than two years prior to the application. The defense of public use was rejected on two grounds: (1) that the use was experimental; and (2) that the use "was not public within the meaning of the statute" (p. 946), because the use of the machine was in secret and "whatever knowledge, if any, was obtained of the machine by the public, was surreptitious and contrary to the manifest wish and intention of the inventor" (pp. 946-7). This second ground of decision is in direct conflict with the decision of the Second Circuit Court of Appeals in the instant case.

In *Jenner* v. *Bowen* (C. C. A. 6) 139 Fed. 556 the patent was for a machine for making bottle wrappers. The inventor assigned to Bowen the exclusive right to make and sell an "improved paper bottle wrapper". No patent was obtained for the wrapper but the inventor designed and built the machine of the patent for Bowen at an agreed price. Bowen agreed to pay royalties and the inventor's livelihood depended on the income derived from the use of the machine and the sale of the bottle wrappers. This commercial use of the machine went on for more than two years prior to the filing of the application. The only defense considered by the Court of Appeals in that case was

that the patented invention was in public use for more than two years prior to the date of the application for a patent. The Court examined the evidence and found that the machine was readily accessible and that the employees of the owners were under no obligation of secrecy. It held the use to be a public use.

In this *Jenner* case, as in the *Manning* case and in the *Smith* v. *Sprague* case in this court (*ante*, pp. 15-17), the whole inquiry as to the public character of the use of the machine would have been unnecessary if the sale of the product of the machine prior to the two year period automatically barred the patent. The decision is therefore by necessary implication in conflict with the decision of the Second Circuit Court of Appeals in the instant case.

In *Paraffine Companies, Inc.* v. *McEverlast, Inc.* (C. C. A. 9) 84 F. 2d 335 the patent was for a machine for wrapping pipe. A similar machine had been used by a stranger to the inventor more than two years prior to the application and the wrapped pipe had been sold in large quantities. On the question of public use, the court noted the difference between the sale of the patented thing to the public and the use of it to produce goods to be sold and conceived the issue to be whether the use of the machine was concealed from the public (p. 340). Finding that there was not the slightest evidence that the machine was kept secret, it held the use of the machine to be a public use. (p. 341)

This case, like the *Shimadzu* case in this Court, is in conflict with the decision of the Second Circuit Court of Appeals in the instant case if that decision is predicated on the "public use" provision of the statute.

In *Macbeth-Evans etc. Co.* v. *General Electric Co.*, (C. C. A. 6) 246 Fed. 695, the patentee had used his process secretly for making glass commercially for over nine years before his application. The court held, on the authority of *Pennock* v. *Dialogue* and *Kendall* v. *Winsor*, that the right to a patent had been abandoned. On the facts presented the court found that there was an intent to delay indefinitely application for patent protection while resorting to secrecy to give an effective monopoly in the meantime.

In the District Court the facts were presented on stipulation and the court (Clark, District Judge, 231 Fed. 183, 184) said that the stipulated facts presented two questions (1) abandonment; and (2) prior public use. In the course of his opinion Judge Clark (afterwards Justice Clark) discusses at length the question whether "a use designed to be kept secret may not be a public use" under the statute (188-9). He sustained the defense pleaded which was that "by the course of action described and admitted, the plaintiff and Macbeth forfeited any right to a patent" (184).

The Court of Appeals expressly put aside that portion of the District Court's decision which dealt with the question of public use, and limited its consideration to questions pertinent to abandonment, saying (246 Fed. 698):

> "It is not necessary, we may observe, to consider the portion of the decision below which deals with the question of public use. Our consideration will be limited to questions pertinent to abandonment."

The court went on to say that if the process and the product are distinct things "there are some difficulties in

the way of concluding that secret use of the process resulting in public use and sale of the product constitutes the statutory public use of the invention", and it therefore passed the question, basing its decision wholly on abandonment.

It is clear that if the rule of forfeiture found by the Second Circuit Court of Appeals in the instant case had been known to these experienced judges in the Sixth Circuit, they would have had no occasion to struggle with either one of the questions which they disposed of in the *Macbeth-Evans* case. The facts there stipulated show secret use by the inventor with a commercial purpose for more than two years prior to the application, thus presenting without question all of the facts which were found by the Second Circuit Court of Appeals to create the forfeiture, apart from any other considerations whatever.

Indeed, we think it is also clear from Judge Warrington's opinion that, if the supposed rule of forfeiture found by the Second Circuit Court of Appeals had been suggested to the Sixth Circuit judges in the *Macbeth-Evans* case, it would have been rejected for the reason that the statute does not in terms provide for such a forfeiture and Congress did not intend to prescribe a distinct period within which a patent must be applied for after an invention is perfected, except in the case of prior patenting or publication or prior public use. Judge Warrington said (702):

> "When the intent then of sections 4886 and 4920, paragraph 5, is kept in mind, they may be as literally interpreted as counsel claim they must be, and yet forbid issue of the patent in suit. The views thus expressed are fortified by the rule that *abandonment may take place at any time.* Elizabeth v.

> Pavement Co., 97 U. S. 126, 134, 24 L. Ed. 1000. That rule differs *and ought to differ* from the statutory rule enacted with reference to the public use of an invention or the act of placing it on sale, since abandonment in itself signifies surrender of the right to a patent. *This would seem to indicate a strong reason, if not the very reason, for the omission to prescribe a distinct period* within which a patent must be applied for after an invention is perfected." (Emphasis ours)*

Finally, as the opinion of the Second Circuit Court of Appeals points out, its decision in the instant case is a direct reversal of its earlier decision in *Peerless etc. Co.* v. *Griffin etc. Co.*, 29 F. 2d, 646 (1928); and is also directly in conflict with the rule established in the Court of Customs and Patent Appeals by the decision of that court in *Stresau* v. *Ipsen*, 77 F. 2d, 937 (1935).

In the District Courts we find two cases in other circuits which are in conflict with the decision of the Second Circuit Court of Appeals in the instant case. They appear to be the only decisions on the subject in those circuits and may be presumed to represent the now prevailing doctrine in those circuits, the First and Fourth.

The first is *Am. Whip Co.* v. *Hampden Whip Co.* (C. C., D. Mass.) 4 Fed. 536 where the patent was for a method of constructing a whipstock. The method was used for making whipstocks which were sold more than two years prior

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* Bills having the aim of inducing filing within a restricted period after the invention is made, by limiting the inventor's proof of priority to a specified period before the application, have been proposed and Congress has not seen fit to adopt them. See H.R. 10156 and H.R. 11019, 72nd Congress.

to application. The patent was sustained because "neither the invention, nor anything which embodies or would be likely to suggest it, is found in the completed whip" (p. 538). The case is therefore in direct conflict with the decision of the Second Circuit Court of Appeals in the instant case.

In *Bryce Bros. Co.* v. *Seneca Glass Co.* (C. C., N. D. West Va.) 140 Fed. 161 the patent was for a machine for engraving glassware. The machine was secretly used in the factory of the inventor's employer and the etched glassware was sold more than two years prior to the application. The defense of public use was rejected on two grounds: (1) because the use of the machine was experimental and (2) because the secret use of the machine was not a public use even though the product of the machine was sold (p. 174). On the second ground of decision, the case presents the same direct conflict with the decision of the Second Circuit Court of Appeals as does the decision of the Third Circuit Court of Appeals in *Penn etc. Co.* v. *Conroy* (*ante*, p. 19).

The Cases Referred to in the Opinion of the Second Circuit Court of Appeals

The difficulty we have found to satisfactorily analyze the ground upon which the Circuit Court of Appeals rested its decision in the instant case is enhanced by the fact that upon examination it appears that in particularly important ways the substance and effect of the cases referred to in that opinion are not correctly stated therein. Despite the superficial suggestion to the contrary that might well be derived from the opinion, the cases referred to therein do

not at all support the conclusion reached by the Court of Appeals nor do they contain any statement of doctrine from which that conclusion could be deduced.

It is said in the Court of Appeals' opinion (284 C) that in *Pennock* v. *Dialogue*, 2 Peters 1, the patent was "for a process of making hose" and that it "did not appear that the joints in any way disclosed the process". Although the opinion does not further elaborate this statement, it plainly suggests that in the *Pennock* case, as in the present case, there was a secret use with a commercial purpose. The fact is that in the *Pennock* case the patent was not for a process but for a hose structure in which the sections were joined together in a certain way. The sale of the hose was a sale of the thing patented and was therefore truly a public use. This appears clearly in the charge of the trial court* and is implicit in the opinion of this court which is studded with references to "the thing invented". The final conclusion of this court was that an inventor loses his right to a patent under the statute then in force "if he suffers the *thing invented* to go into public use, or to be publicly sold for use" before his application (pp. 23-4; emphasis ours). As a matter of decision, the *Pennock* case is therefore not in point on any question arising from secret use. The opinion of the Second Circuit Court of Appeals quotes a part of the famous statement in the *Pennock* case in which this Court adverted to the

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* 19 Fed. Cas. 171 (Case No. 10,491). In speaking of a prior hose, the Court charged that it was for the jury to say whether it is "in form, structure, or principle, the same thing as the hose for which this patent was granted" (p. 173). And again the Court charged "the hose invented by Mr. Bedford more nearly resembles that which the plaintiffs have patented" (p. 173). In similar vein

basic conflict between the power of an inventor to hold back from the knowledge of the public the secrets of his invention and the purpose of the patent law to promote the progress of science and useful arts, but this court in the *Pennock* case resolved that conflict only to the extent of holding that the statute, which then provided only that the invention patented had to be one "not known or used before the application", must be construed to mean that the first inventor cannot acquire a good title to a patent if he suffers the thing invented to go into public use or to be publicly sold for use, before he makes his application for a patent, saying (p. 24):

> "His voluntary act or acquiescence in the *public* sale and use is an abandonment of his right; or rather creates a disability to comply with the terms and conditions on which alone the secretary of state is authorized to grant him a patent." (emphasis ours)

The opinion of the Court of Appeals in the instant case then refers to a similar statement of a basic policy by this

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the Court put it to the jury, to say "whether the hose described by Anderson, and that patented, are the same in principle" (p. 174). In charging on the question of abandonment the Court referred to the hose as "the article so publicly used, and afterwards patented" (p. 174). See also defendant's argument in this Court where counsel said the "averment * * * on which they obtained their patent was, that the rivet hose was a new invention" (2 Peters 8).

The author of the opinion in the instant case was perhaps misled by a statement in the opening of the opinion of this court in *Pennock* v. *Dialogue* that the patent was for an "improvement in the art of making leather tubes or hose" (p. 14). Taken alone, this might indeed support the conclusion of the Court below. But in the light of the positive evidence that the thing patented was the hose, the language can only be interpreted as a loose but not uncommon way of referring to an improvement in an article, which is frequently spoken of as a new way of making the article.

court in *Shaw* v. *Cooper*, 7 Peters 292, 322. That case also was a case of public use of the thing invented *and later patented*. The issue decided was whether the use had been with the inventor's consent.

Then the opinion of the Court of Appeals refers to the decision of this court in *Kendall* v. *Winsor*, quoting a similar general statement of policy from that decision on page 328. The opinion correctly states (285 A) that in the *Kendall* case "the facts presented the same situation as here"; but the Court mistakenly believed that "the jury brought in a verdict for the defendant on the issue of abandonment". The fact is that the "jury found a verdict for plaintiff" (21 How. 322) and this court expressly approved the instruction of the trial court preceding that verdict. Thus, as we have pointed out, the decision of this court in *Kendall* v. *Winsor* was in direct conflict with the decision of the Second Circuit Court of Appeals.

The cases of *Egbert* v. *Lippmann*, 104 U. S. 333 and *Hall* v. *Macneale*, 107 U. S. 90, next referred to in the opinion, both involved a public use of the things patented, an article of commerce.

The first Court of Appeals case referred to in the opinion of the Second Circuit Court of Appeals is *Macbeth-Evans Glass Co.* v. *General Electric Co.*, 246 Fed. 695 (C. C. A. 6). We have already discussed that case (*ante*, pp. 21-2) and have pointed out how erroneously the Second Circuit Court of Appeals interpreted Judge Warrington's remark on page 702.

The second Court of Appeals case relied on in the opinion below is *Allinson Mfg. Co.* v. *Ideal Filter Co.* (C. C. A. 8) 21 F. (2d) 22. The opinion states the facts in that case to be

> "the patent was for a machine for purifying gasoline; the machine was kept secret, but the gasoline had been sold for a period of six years before the application was filed."

This is incorrect. The machine was used by the inventor in his own cleaning establishment to clarify "his gasoline" (p. 24). He was not clarifying gasoline for sale but for his own use. He did sell his gasoline when he sold his business in 1916 but this was clarified by a machine from which his patented improvement had been removed (p. 24). From 1916 on he did nothing with his invention, until he saw a rival machine on the market in 1920. This revived his interest and led him to file this application. The court held that under the circumstances of the case the inventor had abandoned his right to a patent. This ground of decision is correctly stated in the opinion below but the opinion adds: "We are disposed however to read the latter part—pages 27 and 28—as holding that the sale of gasoline was a 'prior use' *of the machine,* notwithstanding its concealment." (Emphasis ours) This interpretation cannot be justified. Apart from the fact that no gasoline was sold and no reference to the sale of gasoline is made in the part of the opinion referred to, the opinion bases its finding of "public use" on the ground that the machine itself was "in plain view" of "at least three employes" who were under no injunction of secrecy (p. 27). The ground of the decision was that there was in fact no "concealment" of the machine. This case therefore affords no support for the rule adopted here. Indeed the case negatives the existence of such a rule for its opinion points out that abandonment is not tied to any statutory time period but is left "at large on facts to be established" (p. 23).

The remainder of the discussion of decided cases in the opinion of the Second Circuit Court of Appeals deals with the decisions of the Court of Customs and Patent Appeals in *Stresau* v. *Ipsen,* 77 Fed. 2d, 937, and with the Second Circuit Court of Appeals' own decisions, particularly *Peerless Roll Leaf Co.* v. *Griffin & Sons,* 29 F. 2d, 646. As we have seen, the opinion recognizes that the *Stresau* case in the Court of Customs and Patent Appeals is directly in conflict, and that the court's decision in the instant case is an express reversal of its earlier decision in the *Peerless* case.

The Court of Appeals has found for the first time a bar to the grant of a patent for a new and useful invention in the secret use of the invention by the inventor partly for experimental purposes but predominantly for a commercial purpose more than one year prior to the filing of his application, and in so doing has far departed from the established rules of statutory interpretation as to call for an exercise of this Court's power of supervision.

The conditions under which a valid patent may be granted are wholly determined by Congressional enactment under Article 1, Section 8, of the Constitution. It is our submission that the Congress by a progressive series of enactments in the light of practical experience has developed a mature and comprehensive plan for reconciling the basic conflict between the power of an inventor to withhold his invention from the public and the constitutional purpose to promote the progress of science and useful arts.

We think those statutory provisions present no need, and leave no room, for the creation of any new limitation

upon the right to a patent by special judicially created rules for particular situations. We think any such new rule should be created only by the Congress where the pros and cons can be submitted to the judgment of the legislators. But if we are wrong in that, we submit that, in the interest of orderly and uniform administration of the patent statutes, the new bar to the grant of a valid patent established by the decision of the Second Circuit Court of Appeals in the instant case should not be allowed to stand unless and until the pros and cons have been presented to and considered by this court.

Aiming to induce prompt filing of a patent application when the inventor is engaging in secret use of his invention for profit, the decision below requires that the application be filed within a year from such a use if the patent is to be valid. But in the light of experience and observation including this very situation and other situations making the prompt filing of patent applications desirable in the public interest, Congress has already created simple and comprehensive statutory provisions to induce promptitude in filing applications. These statutory provisions, deemed by Congress to be adequate and to be a fair reconcilement of the public and private interests involved, leave no room for special judicially created rules for particular situations.

The public interest is affected in two ways by any delay in filing a patent application. First, it postpones the day when the public will come into the free enjoyment of the invention at the end of the patent term; and second, the total period of monopoly is prolonged to the extent that the inventor protects himself by secrecy before filing his ap-

plication. There is no question here as to the reality of this public interest. If nothing else were involved, this public interest would call for a statutory requirement that the inventor file his application at once after making his invention, with only enough time allowed to prepare the application. The problem has always been, however, to reconcile this public interest with the interest, shared alike by the inventor and the public, in allowing some period for "completing an invention, or for a test of its value or success by a series of sufficient and practical experiments" (*Kendall* v. *Winsor*, 21 How. 322, 328-9).

The history of this problem with its conflicting interests has been one of interplay between the courts and Congress. The early statute was quite inadequate, and its inadequacy became apparent as the early cases in the courts brought up the conflict of interest under different fact situations. It would be an undue burden here to trace the whole course of the statutory development. It is enough to say that the early tendency of the courts, understandably enough, was to deal with the problem by a judgment in each case under general criteria reflecting the opposing interests and a general desire to reach a reasonable result under all the circumstances of each case. The course of legislation was different and it supplanted the judicial mode of treatment. Congress elected to deal with part of the problem by a simple and arbitrary formula without attempt at distinction among different fact situations. The culmination of this was the provision as to prior patenting or publication or prior public use in the statute of 1870, which is the present statute in all essentials of mode of treatment with a difference only in the change of the period of grace from two years to one year.

So far as it is pertinent here, this statute (R.S. 4886) which governs the grant of patents contains two conditions which have the purpose and effect of causing inventors to apply for patent promptly, while also providing for the necessary time for completion of the invention and sufficient practical tests of its value:

1. Regardless of when he made the invention, the inventor is barred if any of several events occur more than a year before the filing of his application, namely: public use or sale of the invention in the United States by anyone, the inventor or anyone else; or a patenting of it or a description of it in a printed publication anywhere by anyone, unless the patenting was by the same inventor on an application filed in a foreign country within a year before his application in this country (R.S. 4887).

2. The inventor is barred also if he has abandoned the invention, whether within or prior to the year preceding his application.

The first group of statutory bars is characterized by their arbitrary and automatic effect. No account is taken of the circumstances or of the purpose or intent of the inventor in delaying the filing of his application. Congress has dealt with the matter on a broad basis, fixing an arbitrary and invariable time limit which has to justify itself in its operation on the average, not in the particular case.

The relation of this set of statutory conditions to the public interest in early filing is plain and direct. An inventor is put under a powerful stimulus to file within a year after he makes his invention, for if he delays longer he runs the risk that some public use or sale, or patent, or

printed publication, of which he may have no real means of notice will arise to bar his patent.

The further condition of the statute, that the invention must not have been abandoned, gives further protection of the public interest. It applies, without any year of grace, alike to the case of abandonment by non-use and that of secret use. The decision in *Macbeth-Evans Glass Co.* v. *General Electric Co.*, 246 Fed. 695, illustrates the effectiveness of this statutory condition to embrace the situation of an inventor who elects to rely on secrecy for protection and then resorts to patenting when secrecy fails. The significant fact about this abandonment provision is that it has no arbitrary time limit but leaves the question for decision on all the facts of the particular case.

The Second Circuit Court of Appeals in the instant case did not discuss the matter in relation to this statutory method of dealing with the problem of inducing early filing. Whether because it thought it inadequate or because it did not note its existence, the court supplemented it by its new requirement that for a valid patent the application must be filed within a year from a secret use by the inventor, when that use had a commercial purpose (profit) along with its experimental purpose.

The question here is not whether this legislative system is ideal. Some might well think it better to deal with each category of the problem by a provision aimed at nicer justice. The fact is that Congress has dealt with the whole problem on an informed basis and whatever it has deemed adequate to protect the public interest in question should, we submit, be accepted as final and complete until Congress changes it. At any rate, we must respectfully urge upon

this court that such a change, of general significance, as the Second Circuit Court of Appeals has made in the provisions of the patent law as heretofore understood and applied, should now be reviewed by this court, in the interest of an orderly and uniform administration of the patent statutes.

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